Application No. 10/001,494
Attorney Docket No. 12598US03

REMARKS

The present application includes claims 21-43. Claims 21-43 were rejected.

Claims 40-43 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable of claims 25-26 of U.S. Patent No. 6,368,647. A Terminal Disclaimer in favor of U.S. Patent No. 6,368,647 has been submitted with this response. Consequently, the Applicant respectfully submits that claims 40-43 are allowable.

Claims 21-39 were rejected under 35 U.S.C. §101 statutory double patenting as claiming the same invention as that of claims 1, 6-10, 12-18, and 23-26 of U.S. Patent No. 6,368,647. Statutory double patenting is discussed at MPEP §804 II A. The MPEP recites that

> "A reliable test for double patenting under 35 U.S.C. §101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist."

The MPEP recites as an example that a claim reciting a compound having a "halogen" substitutent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substitutent in place of the halogen. The

MPEP reaches this conclusion because "halogen" is broader than "chlorine", although chlorine is a halogen.

In the present claims 21-39, the term "edible material" has been substituted for terms such as "confectionery material" or "confectionery stock". It is respectfully submitted that the term "edible material" is broader than the term "confectionery material". Just as the MPEP states that the term "halogen" is broader than and patentably distinct from the term "chlorine" (even though chlorine is a halogen), the term "edible material" is broader than the term "confectionery material" (even though confectionery material is an edible material).

With regard to the test recited in the MPEP of whether the claim in the application could be literally infringed without literally infringing the corresponding claim in the patent, an edible material that is not a confectionery would appear to be outside the scope of the literal language of the claims of the patent, yet inside the scope of the literal language of the claims of the present application.

Conversely, in order to maintain the present rejection, the Examiner must find the two terms to be co-extensive in scope. Should this occur, the Applicants, in their efforts to assert the parent patent may be entitled to rely on the present prosecution history to expand the scope of the claim term "confectionery" to read on any edible material.

However, the Applicants respectfully submit, and would prefer that the Examiner acknowledge, that the terms "confectionery material" and "edible material" differ in scope and are consequently patentably distinct. Consequently, the statutory double

patenting rejection is respectfully submitted to be traversed. The Applicants would be more than happy to file a Terminal Disclaimer should the Examiner replace the statutory double patenting rejection with an obviousness-type double patenting rejection.

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CONCLUSION

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: August 21, 2003

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